

Appl. No. : 10/009,575
Filed : August 6, 2002

REMARKS

In response to the Office Action mailed March 17, 2004, Applicant respectfully requests the reconsideration of the application in view of the remarks set forth below. Applicant has amended Claims 19, 29 and 36 as above. Upon the entry of the amendments, Claims 19-36 are pending in this application. The amendments to the claims are merely for clarification and do not narrow the scope of protection. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the remarks set forth below.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 19-36 under 35 U.S.C. § 103(a) as being unpatentable over Olivier (U.S. Patent No. 6,480,885) in view of Scheussler, *et al* (U.S. Patent No. 6,366,950). However, all of the rejected claims are patentable over the prior art references as discussed below. Applicant reserves the right to challenge whether Olivier is available as prior art under § 102(e) against the present application.

Standard of Prima facie Obviousness

In order to provide a *prima facie* showing of obviousness under 35 U.S.C. § 103, all the claim limitations must be taught or suggested by the prior art. *See, e.g., In re Royka*, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974); MPEP 2143.03.

Patentability of Independent Claims

Independent Claim 19 recites, among other limitations, “notifying the recipient if the message is unapproved.” Independent Claims 29-30 and 36 comprise similar limitations. However, as discussed below, neither Olivier nor Scheussler teaches or suggests the above-indicated features of the claimed invention.

1. Olivier Neither Teaches Nor Suggests “Notifying the Recipient If the Message is Unapproved”

Olivier is directed to establishing subscriptions to an electronic mailing list by specifying user profile data and acceptance criteria data to screen other users.

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When the user sends a message to the mailing list, an email server retrieves her 100% matches and then optionally filters her recipient list down to a message distribution list using each recipient's message criteria. The message is then distributed to matching users (column 3, lines 11-21). However, Olivier neither teaches nor suggests the claim terms "*notifying the recipient if the message is unapproved*" as discussed below.

In Olivier, a moderator acts as a human filter for inappropriate messages, scanning for "spam" and other messages that shouldn't be sent to the subscribers. Moderators within the recipient distribution list are located and one or more of the moderators are emailed a request to approve the message for distribution. If the message is not approved, the sender is informed via email (column 14, lines 56-58 and column 15, lines 4-14). That is, Olivier at best discloses that if the message is not approved by the moderator, the sender is informed of that fact via email by the system. This means that the recipient is not notified about the unapproved message and thus is not given an opportunity to see the unapproved message. Furthermore, Applicant respectfully submits that if the Olivier system works for its intended purpose, the recipient must not receive the unapproved message and is not notified about the unapproved message.

In contrast, in the claimed invention, *the recipient is notified* about the unapproved message. One embodiment of the claimed invention has an advantage over Olivier in that the recipient is provided with the capability to manage unsolicited or unapproved e-mail messages without having the messages inadvertently removed by a message (or spam) filter (see the specification at page 20, lines 20-22). That is, the recipient, at his own discretion, can view an unapproved message or delete the message (see, for example, dependent Claims 20 and 26, Figure 2). In view of the above, Olivier neither teaches nor suggests the above-recited claim terms. Furthermore, the Examiner confirmed in this Office Action that Olivier does not explicitly disclose the use of notifying the recipient if the message is unapproved.

2. Scheussler Neither Teaches Nor Suggests "Notifying the Recipient If the Message is Unapproved"

Scheussler does not teach or suggest the claim terms "notifying the recipient if the message is unapproved," either. Referring to column 6, line 67 through column 7, line 5,

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Scheussler discloses that the user can create a contact list in which all authorized users are listed, and if the ID number for a received email does not match to the ID number stored for an authorized user from the contact list, the email will be rejected. That is, Scheussler at best discloses that emails from unauthorized/unidentified computers can be blocked or rejected.

The Examiner asserts that the above teaching of Scheussler discloses the claimed notifying the recipient and storing the message if the message is unapproved. Applicant respectfully disagrees. First of all, Applicant respectfully submits that there is no basis for the Examiner's assertion. Nothing in Scheussler teaches or suggests that the user or recipient is notified about unauthorized emails. Scheussler only teaches that unauthorized emails are blocked or rejected in order to prevent the user from receiving undesired emails (column 7, lines 1-8). According to the Scheussler system, the recipient is not given an opportunity to see the unauthorized emails. In contrast, as discussed above, in the claimed invention, *the recipient is notified* about the unapproved message so that the recipient can manage unapproved e-mail messages by himself. In view of the above, Scheussler neither teaches nor suggests the above-recited claim term.

3. The Combination of Olivier and Scheussler does Not Teach or Suggest "Notifying the Recipient If the Message is Unapproved"

As discussed above, since neither Olivier nor Scheussler teaches or suggests the claim terms "notifying the recipient if the message is unapproved," the combination of the Olivier and Scheussler references does not teach or suggest the above-recited claim term.

4. No Motivation to Combine Olivier and Scheussler to Arrive at the Claimed Invention Exists

The Examiner asserts that one having ordinary skill in the art would have been motivated to utilize the teachings of Scheussler into the Olivier system because that would provide the Olivier's system with the enhanced capability of preventing the user from receiving undesired e-mail from individuals. Applicant respectfully disagrees for the following reasons.

The claimed invention is directed to overcoming the disadvantage of a filtering system, such as in Olivier and Scheussler, which inadvertently can delete an unapproved or unauthorized

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message that may be useful to the recipient. However, both of the Olivier and Scheussler systems are directed to rejecting or blocking unauthorized messages so that the user will not receive any undesired or unapproved emails. Furthermore, the Examiner asserts that the combination of the Olivier and Scheussler systems can enhance the capability of preventing the user from receiving undesired e-mail. In contrast, in the claimed invention, the recipient is notified about an unapproved message. In this way, for example he can decide by himself how to handle the unapproved message. In view of the above, both Olivier and Scheussler, and the Examiner's basis for motivation, teach away from the claimed invention.

5. Summary

In view of the above, neither Olivier nor Scheussler teaches or suggests the above-recited claim terms. Furthermore, there is no motivation to combine the prior art references to arrive at the claimed invention. Thus, the prior art references do not establish *prima facie* of obviousness. Therefore, independent Claims 19, 29-30 and 36 are allowable over the prior art references. Applicant respectfully requests withdrawal of the rejections.

Patentability of Dependent Claims

Dependent Claims 20-28 and 31-35 incorporate the features of their respective base Claim 19 or 30, pursuant to 35 U.S.C. §112, ¶4 and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of their additional technical features, the dependent claims are patentable over the prior art of record.

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CONCLUSION

In view of the Applicant's foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6/16/04

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